



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/429,196	10/28/1999	STEVEN D. FAUST	V5735	5642

7590

06/03/2003

MARC E FINEMAN
KEGAN & KEGAN LTD
79 W MONROE ST
NO 1320
CHICAGO, IL 606034969

EXAMINER

RAHIMI, IRAJ A

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/429,196

Applicant(s)

FAUST ET AL.

Examiner

(Iraj) Alan Rahimi

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>8</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Response to Amendment

1. In papers filed on March 27, 2003, applicant made a minor correction to specification. New drawings were also received indicating the figure numbers, thus objection to the drawings is removed.

Response to Arguments

2. Applicant argues that Freedman does not, and cannot, actually produce the product and therefore Freedman does not teach or disclose “*a means for automatically formatting*” because a means for automatically formatting is required only when a product is actually produced. Examiner respectfully disagrees and takes the attention of the applicant to column 6, lines 55-63 where Freedman discloses a printer facility terminal 36 that can be used in small printing companies having only a single location or plurality of such terminals used by larger printing facilities. Having directed the print jobs to these terminals, it would have been obvious to output the print job to these printing terminals, which include printer 40 for printing of the job. Therefore, contrary to applicant arguments a print product can be actually produced at the printing facility.

Applicant argues that Freedman does not disclose as claim 1 recites “*means for automatically formatting data on said electronic graphic template according to said customer’s corporate identity specification to form a populated and formatted template.*”

Examiner disagrees and would like to present column 8, lines 21-24 to show that Freedman teaching “a requester selecting a printing parameter design template which have been previously established for a particular type of printing job” is equivalent to customer corporate identity

specification. And Freedman's teaching for "... batch loading the entire manuscript into the computer in the desired form" in column 8, lines 45-48 equates to automatic formatting of data on electronic graphic template.

As noted above Freedman teaches selection of printing templates that have been established and then loading the printing data into the template for output as designed by the template.

Although Freedman also discloses pricing information associated with the job and selection of suitable printing facility, such disclosures are not the sole disclosures of Freedman as applicant would like to assert.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman (US patent 4,839,829).

Regarding claim 1, Freedman discloses an automated typesetting system used for production of a commercially-printed product according to a customer's corporate identity specifications, comprising:

means for creating, designing, storing, accessing, and updating an electronic graphic template of the product according to the customer's corporate identity specifications (Fig. 1A; column 8, lines 21-45 & 56-68);

Art Unit: 2622

means for creating, designing, programming, storing, accessing, and updating an electronic database file, wherein said database file is programmed to receive and store populating data used to populate said template and said database file is further programmed with instructions and parameters used to format said populating data on said template according to the customer's corporate identity specifications (column 7, lines 37-52 and column 8, lines 21-24); means for inputting said populating data into said database file as database records (Figure 1A, terminals 14 and 38) ; means for automatically populating said populating data into said template (column 8, lines 45-48); and means for automatically formatting said populating data on said electronic graphic template according to the customer's corporate identity specifications to form a populated and formatted template (column 8, lines 40-44). Freedman refers to the programmed computer 20 for storage of database containing the information for a job. The programmed computer also holds the software for running this application. Although Freedman may not clearly state printing of the product, it states in column 6, lines 55-63 that a printing terminals 36 in small and large printing facilities are employed in a single location or multiple locations which include printer 40. Therefore, it would have been obvious to a person skilled in the art, at the time of invention to utilize such printing terminals to produce the print job.

Regarding claim 2, Freedman discloses an automated typesetting system of claim 1 further comprising a means for automatically printing said populated and formatted template (column 7, lines 58-61 and column 8, lines 45-48).

Regarding claim 3, Freedman discloses an automated typesetting system of claims 1 or 2, in which said template is comprised of at least one block designed to contain populating data in the form of text or graphics. In column 8, lines 36-44 Freedman teaches different manuscript formats like book and newsletter. Such formats allow for text and graphics. He also teaches accepting scanned graphics in column 8, lines 19-21.

Regarding claim 4, Freedman discloses an automated typesetting system of claims 1 or 2, in which said database file is comprised of at least one field designed to contain populating data and at least one field designed to contain instructions and parameters used to format said populating data on said template according to the customer's corporate identity specifications. Freedman considers in column 7, lines 37-58 all parameters for printing a job. Such parameters in the printing environment include data and format information.

Regarding claim 5, Freedman discloses an automated typesetting system of claims 1 or 2, in which said means for creating, designing, storing, accessing, and updating an electronic graphic template comprises a computer software program and said means for creating, designing, programming, storing, accessing, and updating an electronic database file comprises a computer software program (column 3, lines 57-62). The programmed computer 20 contains the software/program for executing the function described in his invention.

Regarding claim 7, Freedman discloses an automated typesetting system of claims 1 or 2 further comprising a means for electronically proof checking and correcting said populating data prior to automatically populating said populating data into said template (column 9, lines 18-22).

Regarding claim 8, Freedman discloses an automated typesetting system of claims 1 or 2, in which said means for automatically populating said populating data into said template further comprises a means for fully populating said template should said populating data not fully populate said template (column 11, lines 36-38). Freedman also teaches that print manager has the ability to add additional information in the computer such as special stock dimension, color or plate size to complete the job.

Regarding claim 9, Freedman discloses an automated typesetting system of claims 1 or 2 interactively coupled with an automated order tracking, billing, shipping, and inventory control system (column 8, lines 1-9; column 10, lines 15-24, 36-38, 55-63; column 11, lines 1-50).

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman in view of Cupps et al. (U.S. Patent 5,991,739).

Regarding claim 6, Freedman does not disclose an automated typesetting system of claims 1 or 2, in which said means for inputting said populating data into said database file as database records comprises:

a Web site programmed to receive said populating data; and a populating data import means for automatically importing said populating data into said database file as database records.

Art Unit: 2622

Cupps et al. discloses an Internet on line order service wherein a customer is given access to a web site to facilitate ordering (column 2, lines 19-38; column 4, lines 60-68 and column 5, lines 1-5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to modify Freedman wherein the on-line communication link is the Internet. It would have been obvious to a person skilled in the art to combine teaching of Cupps et al. with Freedman et al. to provide customers with greater access to the system from remote locations.

Contact Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Iraj) Alan Rahimi whose telephone number is 703-306-3473. The examiner can normally be reached on Mon.-Fri. 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.



Alan Rahimi
May 29, 2003



EDWARD COLES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER